

## REMARKS

Applicants resubmit this Amendment and Response, previously submitted on June 15, 2001 to address the Office Action having a mailing date of April 3, 2001, in reply to correspondence from the U.S. Patent & Trademark Office dated April 17, 2002. In the latter correspondence, the Examiner noted that the amendments to the specification and claims were not in compliance with 37 CFR 1.173(b). Accordingly, the Applicants have made corrective actions to amend the reissue application, and hereby resubmit the Amendment and Response as a supplemental paper.

The amendments to claims 21, 30, 33 and 35 represent amendments to claims not found in the original patent but which were previously submitted in the reissue application. In line 7 of claim 21, Applicants have changed the phrase "the output end of the lights guide" to read "the output end of the light guide" to correct an objection to the informality of the word "lights" as noted below. In lines 1-2 of claim 30, Applicants have changed the phrase "the binocular telescope" to read "a binocular telescope" to correct an informality. In line 1 of claim 33, Applicants have changed the phrase "Claims 21, 22 or 23" to read "Claims 21 or 22" to reduce the multiple dependency. In line 1 of claim 35, Applicants have changed the phrase "Claims 21, 22 or 23" to read "Claims 21 or 22" to reduce the multiple dependency. In line 2 of claim 35, Applicants have changed the phrase "opposing guides plane face" to "an opposing planar face" to correct an informality. In line 3 of claim 35, Applicants have changed the phrase "said aspheric face faces upwardly" to read "said aspheric face faces inwardly" to correct an informality. Support for this change is found at least in Figures 4 and 5

and at column 7, lines 6-10 of the patent in which the inward orientation of the aspheric face is disclosed.

#### Reissue Applications: Litigation Information

With respect to Applicants' obligation under 37 C.F.R. 1.56 to timely apprise the office of any litigation information involving Patent No. 5,667,291, Applicants filed a Submission of Materials under MPEP 2001.06(c) on June 6, 2001.

#### Acknowledgment of Allowable Claims

Applicants acknowledge with appreciation the Examiner's indication that Claims 1-20, 22, 24-27, 34 and 36-53 are allowed. Claim 21 has merely been objected to for the informality of the word "lights" properly being amended to the word "light".

#### Rejection of Claims 23, 28/23, 29/28/23, 31/23 and 32/31/23

The Examiner rejects the above-referenced claims under 35 U.S.C. 103(a) as being unpatentable over Li et al., in view of Kloots (4,104,709). Although the Examiner admits that Li et al. uses a single optical fiber instead of a bundle of optical fibers, the Examiner apparently contends that this deficiency is cured by Kloots' teaching of the use of a fiberoptic bundle in a fiberoptic head lamp for the purpose of increasing the amount of light available from the head lamp. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to substitute a fiberoptic bundle for Li et al.'s single optical fiber for the purpose of increasing the head lamps available light. The Examiner further contends that with respect to Claims 28/23,

29/28/23, 31/23 and 32/31/23, Figure 1(d) of Li et al. teaches that an illumination assembly can be attached to surgical glasses by a pivotally mounted clip. Applicants respectfully traverse the Examiner's rejection of claims for the reasons as set forth below.

The Kloots '709 patent describes an illumination device which provides a continuously variable spot size. Several optical elements are required in order to produce a properly sized, well-defined, uniform spot. Such optical elements must generally be made of heavy, high-grade refractive glass to decrease their size and increase their optical quality, and as such, the optical elements in such devices comprise a substantial percentage of the illumination assemblies overall weight.

Li et al. specifies that the surgical illumination system thereof comprises a "single" fiberoptic delivery light guide. (See, e.g., column 5, lines 60-64; column 6, lines 38-68). Li et al. specifically directs one of skill in the art to select a single core optical fiber having particular diameters, claddings, etc. Li et al. directs one of skill in the art "to utilize in the present invention fiberoptics having a diameter not larger than 1.0 mm since optical fibers having larger diameters transmit a greater amount of light, but have a lower flexibility which decreases by the cube of the radius of the fiber." (Column 6, lines 55-60). Li et al. can be viewed as a teaching away of the use of any fiber or fibers having a combined diameter of more than 1.0 millimeters, given the inflexibility of such a fiberoptic element. Although Li et al. indicates that fiberoptic bundle delivery cables can be utilized, they are only to be used "as long as the optical fibers of the bundle are few in number and each of the fibers comprises a small diameter." (Column 7, lines 21-28).

Applicants contend that Li et al. directly teaches away from the use of fiberoptic bundles and direct one of skill in the art to use single fiber delivery light guides because they are "significantly lighter than the fiber bundles" used in the prior art for transmitting light from the source to the illumination system. Thus, Applicants believe the Examiner's attempt to combine Kloots '709 with Li et al. is improper given the contrary teachings and suggestions contained therein (e.g., Li et al. stresses the need for a significantly lighter light guide than is possible using prior art (i.e., Kloots) fiberoptic bundles). The 1995 patent to Li et al. essentially directs one of skill in the art away from the use of fiber optic bundles as taught by the prior art - which Applicants contend includes the 1978 Kloots '709 patent. The Examiner cannot simply ignore this explicit teaching away.

Applicants submit that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hospital Systems v. Montofiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1974). It is well established that an evaluation of the obviousness or non-obviousness of claims must not be made with the benefit of hindsight using the present application as a blueprint to reconstruct the claimed invention from the references. See Interconnect Planning Corporation v. Feil, 227 USPQ 543 (Fed. Cir. 1985). To draw on hindsight knowledge of the patented invention, when the prior art does not contain or suggest that knowledge, is to use the invention as a template for its own reconstruction -- an illogical and inappropriate process by which to determine patentability. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). "That the prior art may be modified in

the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The mere fact that the individual elements of the inventions are old and can be found in the prior art is irrelevant. Grain Processing Corp. v. American Maize Products Co., 5 USPQ2d 1788 (Fed. Cir. 1988). It is also well established that the Examiner should not be able to pick and choose individual elements from multiple references to recreate the invention. Polaroid Corp. v. Eastman Kodak Co., 229 USPQ 561 (Fed. Cir.), *cert. denied*, 479 U.S. 850 (1996). In determining the scope and content of the prior art, and determining whether the prior art suggested the claimed invention, the references "must be read as whole and consideration must be given where the references diverge and teach away from the claimed invention." Akzo N.V. v. United States Int'l Trade Commission, 1 USPQ2d 1241 (Fed. Cir. 1986) *cert denied*, U.S. 909 (1987) (emphasis supplied); Panduit Corp. v. Dennison Mfg. Co., 1 USPQ2d 1593 (Fed. Cir.) *cert denied*, 481 U.S. 1052 (1987). Here, the 1995 Li et al. patent teaches away from the use of prior art fiberoptic bundles as depicted in the 1978 Kloots '709 patent. Applicants respectfully request the Examiner's reconsideration and withdrawal of all rejections predicated upon a combination of such references.

#### New Claims 54-56

Applicants have presented new Claims 54-56 which are substantially identical to previously numbered Claims 21, 22 and 36. However, each of these new claims eliminates the restriction/limitation of comprising an aspheric lens.

## CONCLUSION

Applicants have made a bona fide effort to respond to each and every requirement set forth in the Office Action. In the event that any issues remain outstanding, the Examiner is invited to contact the undersigned to expedite issuance of this application.

Applicants do not believe there are any fees due in connection with filing this communication. If, however, additional fees are necessary as a result of this communication, the Commissioner is hereby authorized to charge any under-payment or fees associated with this communication or credit any over-payment to Deposit Account No. 23-3000.

Respectfully submitted,

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